

## **REMARKS**

Claims 1, 3-7, 9, and 12-29 are pending but stand rejected. Claim 18 and 26-28 have been withdrawn from further consideration as being directed to a non-elected species. Claims 1, 3, 4, 6, 7, 12, 13, 20, and 21 have been amended. Claims 2, 8, 10, 11, 30, and 31 have been cancelled. In view of the amendments and the following remarks, the Applicant respectfully requests the Examiner's thoughtful reconsideration.

**CLAIM REJECTIONS – 35 USC §112:** The Examiner rejected Claims 1, 3-5, 12-17, 19 and 22 for failing to comply with the written description requirement of §112. The Examiner asserts that the Claims contain subject matter not described in the specification as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the claimed invention. Claim 1 has been amended to address the Examiner's concerns.

Claims 14 and 22 were rejected for failing to comply with the written description requirement of §112. The Examiner asserted that the Specification does not describe "prompts for different standard photo sizes correspond to maximum printable area on a sheet." Claim 14 has been amended to address the Examiner's concerns.

The Applicant questions the Examiner's rejection of Claim 22 as that claim does not recite "prompts for different standard photo sizes correspond to maximum printable area on a sheet." Instead, Claim 22 recites "a set of entries for different standard photo sizes corresponding to maximum printable area on a sheet." This is clearly supported by the Specification. For Example, page 4, line 19 through page 5, line 12, reproduced below, expressly describes such a set of entries.

The ROM 22 also stores a list of entries for the Photo Features function. When the Photo Features function is entered, the controller 16 displays a first entry on the LCD 28. Pressing the +/- button 38 causes the controller 16 to display other entries. Some of the entries may include:

- Original -> 9 wallets
- Original -> 4 3"x5"

- Original -> 2 5"x7"
- Original -> 1 8"x10"
- Photo Package

An entry may be selected by pressing the +1- button 34 until that entry is displayed and then pressing the Select button 32. Placing an original on a glass pane of the scan module 12, selecting the Original -> 9 wallets entry and pressing the Copy button 30 causes the digital copying machine 10 to scan the original and print out a single 8.5"x11" sheet having 9 wallet size copies. Selecting the Original -> 4 3"x5" entry and pressing the Copy button 30 causes four 3"x5" copies to be printed out on a single 8.5x11" sheet. Selecting the Original -> 2 5"x7" entry and pressing the Copy button 30 causes two 5"x7" copies to be printed out on a single 8.5x11" sheet. Selecting the Original -> 1 8"x10" entry and pressing the Copy button 30 causes a single 8"x10" copy to be printed out on a single 8.5x11" sheet. Selecting the Photo Package entry and pressing the Copy button 30 causes the digital copying machine 10 to print out nine wallet size 10 copies on a first sheet of paper, four 3"x5" copies on a second sheet of paper, two 5"x7" copies on a third sheet of paper, and a single 8"x10" copy on a fourth sheet of paper.

The bullet list represents a set of entries for different standard photo sizes, wallet, 3" x 5", 5" x 7", and 8" x 10". Each such entry for a different standard photo size also corresponds to a maximum printable area on a sheet. To explain, physical size limitation of a standard letter sized sheet dictate that only 9 wallet sized images can fit upon such a sheet. The same is true for the specified numbers of the other various sizes. Consequently, the Specification describes prompts for the various standard photo sizes where those prompts correspond to a maximum printable area on a sheet.

**CLAIM REJECTIONS – 35 USC §103:** The Examiner rejected Claims 1-31 citing various USPN 4,994,827 issued to Jamzadeh in view of USPN 4,706,099 in view of Suzuki.

**Claim 1,** as amended, is directed to an apparatus for scanning an image and printing copies of the image on a sheet and recites the following:

1. a scan module;
2. a print module;

3. an input device for allowing a plurality of different standard photo sizes to be selected;
4. means for causing the scan module to scan images from originals of varying sizes in response to a selection via the input device; and
5. means for automatically determining actual sizes of scanned images, automatically scaling first copies of a first scanned image of an original to a first selected photo size, automatically scaling second copies of a second scanned image of that original to a second selected photo size, automatically causing the print module to print first copies on a first sheet, and automatically causing the print module to print the second copies on a second sheet.

The Examiner contends that Jamzadeh teaches a device that can generate print first copies of a scanned image of an original on a sheet and then, following a subsequent use of the original by a user, generate second copies on another sheet. In other words, The Examiner contends that Jamzadeh teaches that a user can manually cause a device to print first sized copies of an original on a first sheet and that the user can, at a later time, manually cause the same device to print second sized copies of that original on a second sheet.

As amended, Claim 1 recites a means for automatically causing the print module to print first copies on a first sheet. That means is also for automatically causing the print module to print the second copies on a second sheet. Jamzadeh does not teach a means for automatically causing the print module to print first copies on a first sheet, and automatically causing the print module to print the second copies on a second sheet. As admitted by the Examiner, Jamzadeh requires user's manual interaction to print the second copies. Suzuki is silent on this point.

Consequently, the cited references fail to teach or suggest an apparatus that includes "means for ... automatically causing the print module to print first copies on a first sheet, and automatically causing the print module to print the second copies on a second sheet." For at least this reasons, Claim 1 is patentable over the cited references as are Claims 3-5 and 12-19 which depend from Claim 1.

**Claim 6** is directed to an apparatus for scanning an image and printing copies of an image on a sheet and, as amended, recites the following:

1. a scan module;
2. a print module;
3. an input device for allowing a plurality of different standard photo sizes to be selected; and
4. a controller for causing the scan module to scan the image from an original of a plurality of sizes, the controller automatically determining actual size of the scanned image, automatically generating first scanned image copies that are scaled to a first selected photo size and that are positioned to utilize maximum printable area on a first sheet, automatically generating second scanned image copies that are scaled to second selected photo size and that are positioned to utilize maximum printable area on a second sheet, and automatically causing the print module to print the first copies on the first sheet and to then print the second copies of the scanned image on the second sheet.

Not unlike Claim 1, Claim 6 recites a controller for “automatically causing the print module to print the first copies on the first sheet and to then print the second copies of the scanned image on the second sheet.” As with Claim 1 Jamzadeh requires user’s manual interaction to print the second copies. Suzuki is silent on this point.

Consequently, the cited references fail to teach or suggest an apparatus that includes a controller as recited by Claim 6. For at least this reason, Claim 6 is patentable over the cited references as are Claims 7, 9, and 20-29 which depend from Claim 6.

**CONCLUSION:** The foregoing is believed to be a complete response to the outstanding Office Action. Claims 1, 3-7, 9, and 12-29 are in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

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